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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,648	03/30/2001	David W. Cannell	5725.0843-00	3537
7590	03/24/2005		EXAMINER	
Thomas L. Irving FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	
DATE MAILED: 03/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/820,648	CANNELL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	JYOTHSNA A. VENKAT Ph. D	1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-167 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-167 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

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**DETAILED ACTION**

Receipt is acknowledged of election filed on 11/29/04. Upon further review of the claims, the restriction requirement dated 8/27/04 is withdrawn. Claims 1-167 are pending in the application and the status of the claims are as follows:

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 16-18, 28, 64-66, 77, 102-104, 115, 136-138 and 149 are drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber comprising C5-C7 saccharide unit substituted with at least one amino group, method of use and kit wherein the saccharide unit is C5 substituted with at least one amino group chosen from **pentosamines**, classified in class 424, subclass 70.2.
  - II. Claims 19-21, 30-31, 67-69, 78-79, 105-107, 116-117, 139-141, and 150-151 are drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber comprising C5-C7 saccharide unit substituted with at least one amino group, method of use and kit wherein the saccharide unit is C6 substituted with at least one amino group chosen from **hexasoamines** classified in class 424, subclass 70.1.
  - III. Claims 22-23, 70-71, 108-109, and 142-143 are drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber comprising C5-C7 saccharide unit substituted with at least one amino group, method of use and kit wherein the saccharide unit is C7

substituted with at least one amino group chosen from **heptasoamines** classified in class 424, subclass 70.1.

IV. Claims 24, 72, 110 and 144 are, drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber, method of use and kit where in at least one compound is chosen from **oligosaccharides derived from said at least one C5-C7 saccharide unit substituted with at least one amino group classified** in class 424, subclass 70.1.

V. Claims 25, 73, 111, and 145 are drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber comprising C5-C7 saccharide unit substituted with at least one amino group, method of use and kit wherein said at least one C5-C7 saccharide unit is chosen from **furanoses and derivatives thereof** classified in class 424, subclass 70.1.

VI. Claims 26-28, 74-76, 112-114, and 146-148 are drawn to a composition for durable non-permanent shaping or durable retention of non-permanent shape of at least one keratinous fiber comprising C5-C7 saccharide unit substituted with at least one amino group, method of use and kit wherein said at least one C5-C7 saccharide unit is chosen from **derivatives of C5-C7 saccharide units** classified in class 424, subclass 70.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different monosaccharides. Pentoses have 5 carbon atoms and this can be aldoses or ketoses. Hexoses have 6 carbon atoms and heptoses are 7 carbon atoms and furanoses and derivatives have 6-carbon atom and forms ring structure and the derivatives of C5-C7 monosaccharides are various derivatives. All the compounds are structurally dissimilar and all these compounds have different functions and different effects.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VI, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Claims 1-15, 32-63, 80-101,118-135and 152-167, link(s) inventions I and II-VI. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-15, 32-63, 80-101,118-135and 152-167. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction

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requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

6. A telephone call was made to Mark Sweet on 1/6/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JYOTHSNA A VENKAT Ph. D  
Primary Examiner  
Art Unit 1615

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